

Amendments to the Drawings

The attached sheets of drawings include changes to Fig. 3 and an additional Fig. 6. Figure 3 identifies elements 300a-c, 302 a-c, 304 a-c, and 350, as well as element 352. Figure 6 is a flow chart identifying elements 600, 602, 604, 610, 620, 630, 640, 650, 660, and 670.

REMARKS

Drawings

The Examiner has objected to the drawings under 37 C.F.R. 1.83 (a), stating that a number of method steps must be shown in the drawings and that the claimed structural elements must be shown as well, in each case citing examples. The Applicant has both amended the Specification and submitted replacement drawings in response. No new matter has been added. The Applicant also respectfully draws the Examiner's attention to the Specification and drawings to note that some of the examples of elements cited by the Examiner are in fact exemplified in the drawings, for example, an embodiment of the "visual aided field" is shown at **Fig. 1, 12**. As such, the Applicant believes the drawings are presently acceptable and requests that the Examiner withdraw the objection.

Claim Rejections- 35 U.S.C. §112

The Examiner has rejected Claims 1 to 34 as a group under 35 U.S.C. § 112 as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The single paragraph contains what appears to be multiple bases for rejection; which the Applicant will address individually.

First, the Examiner states that the references for the method "steps" are unclear by listing the elements by name. The Examiner gives no reason or basis for the lack of clarity of the terms listed. The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. § 112 , second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. See MPEP, 2173.02 Clarity and Precision.

The Applicant believes that the phrases each of the claims, when read in the respective claims' entirety, are in fact clear. The Examiner, to maintain the rejection, should provide an analysis as to why the phrase(s) used in each claim is unclear. That said, the Applicant urges that the Examiner withdraw the rejection in light of the fact that the claims are clear as recited.

Second, the Examiner has stated that the antecedent basis for "the computer program", "the user interface of the software program", (as per claims 1 and 20) "the sentence phrase, (as per claims 4 and 23) and "the database of all sentence entries based on a filter criteria" (as per claims 18 and 35) have not been clearly set forth. The Applicant thanks the Examiner and has adopted the Examiner's suggestion and amended the claims to provide proper antecedent basis. The Applicant notes that the antecedent basis for "a sentence phrase" in claims 4 and 23 presently recite the proper antecedent basis (i.e., "a") and are thus not amended.

Third, the Examiner alleges that the Applicant has attempted to claim a Markush group for a number of terms. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. Without characterizing the claim type, the Applicant has amended the claims such that it is now definite and clearly sets out the metes and bounds of the claimed apparatus.

Fourth, the Examiner states that the language “such as” (as per claims 8 and 27) and “and so on” (as per claims 10 and 29) are indefinite. The claims have been amended so as to remove the language.

The Applicant urges that the claims of the present application are clear and requests that the rejection under 35 U.S.C. § 112 be withdrawn.

Claim Rejections- 35 U.S.C. § 102

The Examiner has rejected Claims 1-4 and 6-18 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,169,342 to Steel et al. (Steel). The Examiner alleges that Steel teaches, *inter alia*, a software program or spreadsheet program with a plurality of English sentence parts (Figs. 12a-12c), wherein the predefined sentence parts comprising...condition having place or time, and pre-subject having interjection or conjunction, entering each of the predefined English sentence parts into a corresponding input field of a computer program user input interface (F. of Fig. 1), wherein the computer program is adapted to display each input field for each sentence entered and concatenate the plurality of input fields to provide a resultant English sentence for display to a user (G. of Fig. 1).

Claim 1 has been amended to recite that the English sentence parts include a pre-subject. Fig. 12(b) of Steele shows an output tree-structured parse of an English sentence. However, the parse does not show an underlying rule or language structure for a “pre-subject” or a “condition”. Steel instead shows a “Noun phrase”, and a “Verb-phrase” further broken down into a “Verb” and a “Noun- phrase”. The present invention, by identifying the “pre-subject” as categorical linguistic structure for the English language, makes English more readily available to the non-native English speaker (e.g., a Japanese speaker).

To explain, the specification defines the pre-subject as any word, phrase or clause preceding the subject (see pg 3, lines 17-22). The Japanese sentence structure, defined in terms used by the

present invention, is generally constructed as follows: Pre-subject (ps) –Subject (s) – Condition (c)- Object (o)-Predicate (p). The English sentence, on the other hand, generally follows this structure : ps -s- p - o -c. While sentence parts such as subject, predicate, and object are known, by creating the categories of “pre-subject” and “condition”, the present invention presents an English sentence to the native speaker of Japanese in such a way the Japanese native speaker readily appreciates the meaning of an English, because the sentence structure is easily rendered into a Japanese format, which is to say, in the manner in which a Japanese person thinks and speaks. In the absence of the “pre-subject” and “condition”, English sentence structure does not readily parse into Japanese sentence structure.

As such, Steel does not teach or suggest the recitations of independent claims 1, and as claims 2-4 and 6-18 ultimately depend from claim 1, the applicant urges that the these claims are in condition for allowance and that the rejection under 35 U.S.C. § 102 (b) be withdrawn.

Claim Rejections- 35 U.S.C. §103

The Examiner has rejected claims 20 to 23 and 25 to 35 over Steel in view of Rehbein, as well as claims 5, 19, 24 and 36 over Steel in view of Rehbein and further in view of Hillis. As regards claims 5 and 19, as discussed above, Steel does not anticipate the claims of the present invention. Thus, even if Rehbein and Hillis taught or suggested what the Examiner alleges, which it does not, Steel’s deficiency as a reference renders the rejection under 35 U.S.C. §103 moot.

Addressing claims 20 to 23, 25 to 35 and 36, the Applicant respectfully point out two things as regards independent claim 20:

1) While the Examiner discusses a housing suitable for being held in the hand of a student, the Examiner does not address any of the other limitations of claim 20. A reference, alone or in combination with another reference, must anticipate each and every limitation of a claim for a *prima facie* case to be made out.

2) As regards the housing suitable for being held in the hand of a student hand, the Examiner states that it would have been obvious for a skilled artisan to modify the apparatus of Steele with the feature of the hand held housing as taught by Rehbein “so as to provide a hand held device for instructing a student to learn the different type of language”. This is impermissible hindsight as it uses the teaching of the present invention to provide the motivation to combine the references the Examiner cites.

As the rejected claims all ultimately depend from claims 1 and 20, the Applicant urges that the Claims are presently in condition for allowance and respectfully requests that the rejection under 35 U.S.C. § 103 be withdrawn.

Conclusion

Reconsideration and withdrawal of this restriction requirement and an examination of all of the pending claims is requested. It is believed that all of the pending claims are in condition for allowance. Early and favorable action by the Examiner is earnestly solicited. If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned at (212) 801-3170. The undersigned may also be contacted by e-mail at mcguireb@gtlaw.com.


The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 50-1561.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 50-1561.

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Respectfully submitted,

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